

**Remarks/Arguments:**

**I. Status**

The Office Action dated May 6, 2004, has been carefully reviewed. Claims 7 and 11 have been amended to depend from claims 1 and 8, respectively. Claim 16 has been amended to correct a typographical error. New claims 21-24 have been added. Accordingly, claims 1-5, 7-13 and 15-24 are pending in this application. Reconsideration of this application is respectfully requested.

**II. Objections.**

Claim 7 was objected to for depending from canceled claim 6. Claim 7 has been amended to depend from claim 1. Accordingly, it is respectfully submitted that the objection has been overcome.

**III. 35 U.S.C. § 102 Rejection.**

Claims 1-2, 4-5, 7, 11-12 and 18-20 were rejected under 35 U.S.C. § 102 as being anticipated by U.S. Patent No. 6,298,330 to Gardenswartz et al. (hereinafter "Gardenswartz"). Reconsideration of these claims in view of the following remarks is respectfully requested.

**The Present Invention**

The present invention provides a system and method for establishing the context of a consumer/business interaction. In one embodiment, data relating to interactions

between a customer and a business are entered into a database. The interaction data may include customer data, customer account data, mode of interaction, reason for interaction, etc. The stored data is referred to as historical interaction data.

In accordance with the present invention, when the customer interacts with the business, data relating to the present interaction are obtained. These data are called "obtained data". Based upon the obtained data, the historical interaction data is accessed in order to create a context for the interaction. In one embodiment, the historical interaction data is presented to the customer in an actionable format. Thus, by clicking on an icon, the customer is directed to additional information or an application may be launched.

Accordingly, the context allows the business to more rapidly and usefully interact with the customer. For example, if a customer contacts a business to report a problem with an ATM, the context allows the business to understand which specific ATM is being discussed, even if the customer does not have the information to specifically identify the ATM.

Gardenswartz

Gardenswartz discloses a system and method for delivering a targeted advertisement. (Gardenswartz at Abstract). In accordance with Gardenswartz, details regarding a customer's purchasing history are stored. (Id. at column 6, lines 13-14). The purchase behavior of the customer is then classified. (Id. at column 12, lines 38-42). Based upon this classification, a targeted ad profile for the customer is generated. (Id. at column 13, lines 8-10). The targeted ad profile includes a customer identification in the

form of a cookie. (Id. at column 13, lines 18-26). When a customer next visits a website, the customer is identified using the cookie and an advertisement is delivered to the customer based upon at least one of the purchase behavior classifications. (Id. at column 13, line 65 through column 14, line 4).

Discussion Re: Patentability of Claim 1

1.     Claim 1

Claim 1 recites:

A method of operating a business processing unit to generate a context for an interaction between a consumer and a business comprising:

    storing historical interaction data between a consumer and a business in a historical interaction database, the historical interaction data regarding interactions between the business and the consumer;  
    receiving a communication from the consumer through a device to obtain interaction data;  
    accessing in accordance with the obtained interaction data historical interaction data regarding the consumer; and  
    generating from the accessed historical interaction data a context for the communication received from the consumer.

Claim 1 thus recites a method wherein a context for a communication received from a consumer is generated based upon accessed historical interaction.

2.     Anticipation Has Not Been Properly Alleged.

The Office Action appears to allege that Gardenswartz discloses the limitations of claim 1. (Office Action at pages 2-3). However, the Office Action does not identify the claimed limitations of “accessing” and “generating” as being taught by Gardenswartz.

Anticipation under 35 U.S.C. § 102 is proper only if the prior art reference discloses each and every element of the claim. Since Gardenswartz does not disclose each and every element of Applicant’s claim 1, Gardenswartz does not anticipate claim 1.

3.     **Gardenswartz Does Not Teach a Context.**

The Office Action alleges that Gardenswartz teaches matching a cookie with an associated ad profile and delivering an advertisement to a consumer, further alleging that the advertisement is a “context”. (Office Action at pages 2-3). The advertisement of Gardenswartz is not a context as claimed.

The Merriam-Webster Online Dictionary defines “context” as “the parts of a discourse that surround a word or passage and can throw light on its meaning.” (<http://www.merriam-webster.com/cgi-bin/dictionary?book=Dictionary&va=context>). Arguably, the advertisement delivered to a consumer satisfies the first aspect of the definition, in that the advertisement is a part of the discourse between a business and a consumer. However, to be a “context”, the meaning of the consumer’s communication must be illuminated. In other words, a “context” helps one to understand the communication being received from the consumer.

The advertisement of Gardenswartz cannot be read to provide any assistance in understanding a communication from a consumer. Specifically, there does not appear to be anything about a targeted advertisement delivered in response to a consumer’s URL request that helps to understand why a consumer made the URL request. Gardenswartz does not make any such assertion, and the applicants are not aware of how the advertisement of Gardenswartz that is sent to a consumer upon identification of the consumer helps to understand why the consumer has sent a communication.

Claim 1 recites that the context of a received communication be determined. The method of Gardenswartz simply sends an advertisement when a certain cookie is detected. An advertisement that is delivered based upon the identity of a consumer

cannot be said to provide any insight into a received consumer communication.

Therefore, Gardenswartz does not teach a context as claimed. Since Gardenswartz does not disclose each and every element of Applicant's claim 1, Gardenswartz does not anticipate claim 1.

#### 4. Conclusion

For any or all of the foregoing reasons, it is respectfully submitted that the rejection of claim 1 as being anticipated by Gardenswartz has been successfully traversed, and the Applicants respectfully submit that the rejection of claim 1 under 35 U.S.C. § 102 should be withdrawn.

#### Discussion Re: Patentability of Claims 2 and 7

The Office Action rejected claims 2 and 7 based upon Gardenswartz. Claims 2 and 7 depend directly from 1 and include additional limitations. As a result, claims 2 and 7 are allowable for at least the reasons set forth above with respect to claim 1.

#### Discussion Re: Patentability of Claim 4

The Office Action rejected claim 4 for the same reasons set forth in the rejection of claim 1. Claim 4 depends directly from claim 1 and includes additional limitations. As a result, claim 4 is allowable for at least the reasons set forth above with respect to claim 1.

Moreover, claim 4 includes a further limitation that the historical interaction data be transmitted through the device from which the communication was received. The Office Action fails to identify any such teaching in Gardenswartz.

Accordingly, the Applicant respectfully submits that claim 4 is further allowable over the cited art.

Discussion Re: Patentability of Claim 5

As an initial matter, claim 5 depends indirectly from 1 and includes additional limitations. As a result, claim 5 is allowable for at least the reasons set forth above with respect to claim 1.

Moreover, claim 5 recites that the “historical interaction data” be provided to the consumer in a “actionable format”. The Office Action rejected claim 5 alleging that “delivering an advertisement (a context) to the customer inherently indicates customer’s ability to act upon it.” (Office Action at page 3, internal citations omitted). MPEP § 2112 requires the Examiner to provide rationale or evidence tending to show inherency. To establish inherency, the extrinsic evidence must show that the missing descriptive matter is “necessarily present”. (MPEP § 2112). Accordingly, the Office Action has alleged that all advertisements are necessarily in an actionable format.

Respectfully, it is well known that it is not *necessary* for an advertisement to include links to other web pages or applications. Such an advertisement is possible simply by designing the advertisement without any imbedded links.

Therefore, the Office Action has failed to provide evidence or rationale tending to show inherency as required by MPEP § 2112. Therefore, Gardenswartz does not disclose

an actionable format as claimed. Accordingly, the Applicants submit that the rejection of claim 5 should be withdrawn.

Discussion Re: Patentability of Claim 18

The Office Action rejected claim 18 for the same reasons set forth in the rejection of claim 1. Claim 18, although an apparatus claim, recites an apparatus that may be used in performing the method of claim 1. Specifically, claim 18 recites “a context generator” that may be used to generate a context. Accordingly, for the same reasons discussed above with respect to claim 1, Gardenswartz does not disclose a context generator as claimed.

Therefore, it is respectfully submitted that the rejection of claim 18 as being anticipated by Gardenswartz has been successfully traversed, and the Applicants respectfully submit that the rejection of claim 18 under 35 U.S.C. § 102 should be withdrawn.

Discussion Re: Patentability of Claims 19 and 20

The Office Action rejected claims 19 and 20 based upon Gardenswartz. Claims 19 and 20 depend directly from claim 18 and include additional limitations. As a result, claims 19 and 20 are allowable for at least the reasons set forth above with respect to claim 18.

**IV. 35 U.S.C. § 103 Rejection.**

Claims 3, 8-10, 13 and 15-17 were rejected under 35 U.S.C. § 103 as being unpatentable over Gardenswartz. Additionally claims 11-12, although initially rejected under 35 U.S.C. § 102, have been amended to depend directly or indirectly from claim 8. Accordingly, the Applicants address claims 11-12 under this heading. Reconsideration of claims 3, 8-13 and 15-17 in view of the following remarks is respectfully requested.

**Discussion Re: Patentability of Claim 8**

**1. Claim 8**

Claim 8 recites:

A method of interaction between a business and a consumer comprising:  
maintaining a database of past interaction data from previous consumer to business interactions;  
receiving an interaction initiation having interaction data from a consumer;  
accessing in accordance with the received interaction data past interaction data regarding the consumer from the database of past interaction data; and  
generating a context from the past interaction data regarding the consumer that was accessed in accordance with the received interaction data.

Claim 8 thus recites a method wherein past interaction data is accessed and a context is generated from the past interaction data.

**2. Prima Facie Obviousness Has Not Been Alleged**

In rejecting claim 8, the Office Action makes no allegation regarding a step of “accessing” being disclosed in the prior art. (See e.g. Office Action at page 3). The Office Action merely notes that Gardenswartz does not disclose “purchase history of *previous customers*”, and alleges under Official Notice that generation of targeted advertisement based upon an analysis of existing historical purchase history such a modification of Gardenswartz would be obvious. (*Id.* at page 3, emphasis in original).

However, because the Office Action does not identify the step of “assessing” in the prior art, a *prima facie* case of obviousness has not been alleged.

Specifically, the Office Action does not identify the step of “assessing” in the prior art, and the proposed modification of Gardenswartz does not remedy this omission, as it is directed to modification of the contents of a database. MPEP § 2143.03 states that “all the claim limitations must be taught or suggested by the prior art” to establish a case of *prima facie* obviousness. Therefore, because the Office Action has failed to identify any art that either explicitly or inherently discloses the step of assessing as claimed, a *prima facie* case of obviousness has not been made and the rejection of claim 8 under 35 U.S.C. 103(a) should be withdrawn.

### 3. Modification of Gardenswartz Does Not Arrive at the Present Invention

The Office Action relies upon the advertisement of Gardenswartz for teaching of a “context”. However, as discussed above with respect to claim 1, the advertisement of Gardenswartz is not a context as claimed.

Thus, even modifying Gardenswartz to include the “purchase history of previous customers” does not arrive at the invention of claim 8. Therefore, under MPEP § 2143.03, the Examiner has failed to present a *prima facie* case of obviousness and the rejection of claim 8 under 35 U.S.C. 103(a) should be withdrawn.

### 4. Conclusion

For any or all of the foregoing reasons, it is respectfully submitted that the rejection of claim 8 as being obvious over Gardenswartz in view of Official Notice has

been successfully traversed, and the Applicants respectfully submit that the rejection of claim 8 under 35 U.S.C. § 103 should be withdrawn.

**Discussion Re: Patentability of Claims 3, 9-13 and 15-17**

The Office Action rejected claims 3, 9-13 and 15-17 based upon Gardenswartz. Claim 3 depends directly from claim 1 and includes additional limitations. Claims 9-13 and 15-17 depend directly or indirectly either from claim 8 and include additional limitations. As a result, claims 3, 9-13 and 15-17 are allowable for at least the reasons set forth above with respect to either claim 1 or claim 8.

**V.      Claims 21-24**

New claims 21-24 have been added. These claims recite novel and non-obvious limitations. Accordingly, claims 21-24 are believed to be allowable over the prior art.

**VI. Conclusion**

Applicant respectfully requests entry of the amendments and favorable consideration of the application.

A prompt and favorable action on the merits is requested.



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